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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/881,671

**Applicant(s)**

CHERN, VINCENT

**Examiner**

LASHANYA R. NASH

**Art Unit**

2153

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to the request for continued examination filed 4 March 2008. Claims 1-18 and 27-33 are presented for further consideration. Claims 19-26 are cancelled. Claims 27-33 are new. Claims 1, 3, 4, 6, 7, 10-12, and 18 are currently amended.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2008 has been entered.

#### ***Response to Arguments***

Applicant's arguments, see Remarks pages 8-13, filed 3 March 2008, with respect to the rejection of claims 1,4-6,8-10,13,14,16 and 17 under 35 USC §103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of newly found prior art references International Application Publication (WO 99/65256) and UK Patent Application Publication (GB 2345613) as set forth below in the Office action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4-16, 18, 27, 29, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez et al. (International Application Publication WO 99/65256) and Angwin et al. (UK Patent Application Publication GB 2345613), hereinafter referred to as Fernandez and Angwin respectively.**

In reference to claim 1, Fernandez discloses a method employed for accessing electronic messages for mobile devices (abstract). Fernandez further discloses:

- A method for sending an audio file to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device (i.e. mobile phone able to send voice attachment to e-mail; page 4, line 28; page 5, line 15), the method comprising:
- communicatively connecting to a first server over the wireless communications network (i.e. messaging server/main server; page 9, lines 2-26; page 11, lines 18-31) ;
- receiving input from the user selecting an option presented by the first server to send the audio file to the email recipient (i.e. reply to email with an audio file attached to an email; page 12, lines 20);

- communicatively connecting the wireless communication device to a second server (i.e. IVR server) over the wireless communications network in response to the selected option, (i.e. user calls into IVR server after notification received; page 22, line 19-page 23, line 13);
- Recording the audio file on the second server and sending the recorded audio file to the email recipient as part of an email message (page 7, lines 15-20; page 17, lines 1-5).

Although Fernandez discloses substantial features of the invention, the reference fails to expressly disclose wherein the first server transmits a signal to the second server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device. Nonetheless, this would have been an obvious modification to the teachings of Fernandez for one of ordinary skill in the art at the time of the invention, as further evidenced by Angwin.

In an analogous art, Angwin discloses a method employed for establishing an interactive voice session in a wireless network (abstract). Angwin further discloses first server transmits a signal to the second server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device (i.e. identity notification for mobile phone; page 9, lines 25-27), (i.e. alert message triggers establishment of second connection for voice data; page 8, lines 18-45). It would have been obvious for one of ordinary skill in the art to combine the known element of a signal indicating a pending connection with a wireless communication device, as taught by Angwin, with the known elements of a first server

(i.e. main server) and a second server (i.e. IVR sever) connections with a wireless communication device, as taught by Fernandez without modification to their respective functions in order to yield the predictable result of a wireless device connecting to a second server for dedicated voice data communications to record an audio file in response to the selected option with a first server.

In reference to claim 18, Fernandez discloses a method employed for accessing electronic messages for mobile devices (abstract). Fernandez further discloses:

- A method for sending a message to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device (i.e. mobile phone able to send voice attachment to e-mail; page 4, line 28-page 5, line 15), the method comprising:
- Dialing a phone number (i.e. logging into system using users mobile phone number; page 22, lines 5-8) for communicatively connecting the wireless communication device to an email server by a data packet connection over the wireless network (i.e. messaging server/main server; page 9, lines 2-26; page 11, lines 18-31) ;
- receiving input selecting an option presented by the first server to send a voice message to the email recipient (i.e. digitized voice response to email; page 6, lines 10-16);
- communicatively connecting the wireless communication device to an interactive voice response server (i.e. IVR server) over the wireless communications

network in response to the selected option, (i.e. user calls into IVR server after notification received; page 22, line 19-page 23, line 13);

- Recording the voice message on the interactive voice response server; and sending the recorded voice message in an attachment to an email to the email recipient (page 7, lines 15-20; page 17, lines 1-5).

Although Fernandez discloses substantial features of the invention, the reference fails to expressly disclose wherein the email server transmits a signal to the interactive voice response server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device. Nonetheless, this would have been an obvious modification to the teachings of Fernandez for one of ordinary skill in the art at the time of the invention, as further evidenced by Angwin.

In an analogous art, Angwin discloses a method employed for establishing an interactive voice session in a wireless network (abstract). Angwin further discloses first server transmits a signal to the second server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device (i.e. identity notification for mobile phone; page 9, lines 25-27),(i.e. alert message triggers establishment of second connection for voice data; page 8, lines 18-45).It would have been obvious for one of ordinary skill in the art to combine the known element of a signal indicating a pending connection with a wireless communication device, as taught by Angwin, with the known elements of a first server (i.e. main server) and a second server (i.e. IVR sever) connections with a wireless

communication device, as taught by Fernandez without modification to their respective functions in order to yield the predictable result of a wireless device connecting to a second server for dedicated voice data communications to record an audio file in response to the selected option with a first server.

In reference to claim 27, Fernandez discloses a method employed for accessing electronic messages for mobile devices (abstract). Fernandez further discloses:

- A method for sending an audio message in association with an electronic mail (email) message (i.e. mobile phone able to send voice attachment to e-mail; page 4, line 28-page 5, line 15), the method comprising:
- Providing a wireless communication device with access to an email message (i.e. mobile phone connecting to messaging server/main server to retrieve email; page 5, lines 5-12; page 9, lines 2-26; page 11, lines 18-31) ;
- receiving input from the wireless communication device selecting an option to associate an audio file with the email message (i.e. reply to email with an audio file attached to an email; page 12, lines 20);
- instructing the wireless communication device to connect to a voice server (i.e. IVR server), (i.e. user calls into IVR server after notification received using IVR callback number; page 22, line 19-page 23, line 13);
- Receiving input from the voice server indicating that the audio file is available; and transmitting a representation of the audio file in association with the email message (page 7, lines 15-20; page 17, lines 1-5).



Although Fernandez discloses substantial features of the invention, the reference fails to expressly disclose transmitting a signal to the voice server indicating a pending connection with the wireless communication device, wherein the signal including information uniquely identifying the wireless communication device. Nonetheless, this would have been an obvious modification to the teachings of Fernandez for one of ordinary skill in the art at the time of the invention, as further evidenced by Angwin.

In an analogous art, Angwin discloses a method employed for establishing an interactive voice session in a wireless network (abstract). Angwin further discloses first server transmits a signal to the second server indicating a pending connection with the wireless communication device, the signal including information identifying the wireless communication device (i.e. identity notification for mobile phone; page 9, lines 25-27),(i.e. alert message triggers establishment of second connection for voice data; page 8, lines 18-45).It would have been obvious for one of ordinary skill in the art to combine the known element of a signal indicating a pending connection with a wireless communication device, as taught by Angwin, with the known elements of a first server (i.e. main server) and a second server (i.e. IVR sever) connections with a wireless communication device, as taught by Fernandez without modification to their respective functions in order to yield the predictable result of a wireless device connecting to a second server for dedicated voice data communications to record an audio file in response to the selected option with a first server.

In reference to claim 2, Fernandez discloses wherein the step of communicatively connecting to a first server further comprises: dialing a phone number (i.e. logging into system using users mobile phone number; page 22, lines 5-8) for connecting to the first server using the wireless communication device; and establishing a data packet connection between the wireless communication device and the first server (i.e. messaging server/main server; page 9, lines 2-26; page 11, lines 18-31).

In reference to claim 4, Fernandez discloses wherein receiving input from the user selecting an option to send the audio file further comprises: presenting a received email He message on the wireless communication device; receiving input from the user selecting an option to respond to the received email the message; and receiving input from the user selecting an option to attach the audio file to the response to the received email the message (page 5, lines 5-15).

In reference to claim 5, Fernandez discloses wherein the communicatively connecting the wireless communication device to a second server further comprises: terminating the connection with the first server; and establishing an audio connection between the wireless communication device and the second server (page 16, lines 22-31).

In reference to claim 6, Fernandez discloses wherein the signal further includes user identification information (page 22, lines 5-20).

In reference to claim 7, Angwin discloses wherein the terminating the connection with the first server comprises storing a set of state information on the wireless communication device, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to the same state in the first server that existed prior to terminating the connection (page 9, lines 1-27).

In reference to claim 8, Fernandez discloses wherein the recording the audio file comprises: providing an audio input through the wireless communication device; and storing the audio input as an audio file on the second server (page 17, lines 1-5).

In reference to claim 9, Fernandez discloses further comprising providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file, canceling the recording, and sending the audio file to the email recipient (page 6, lines 10-16).

In reference to claim 10, Fernandez discloses wherein the sending the audio file to the email recipient further comprises: transmitting a signal to the first server indicating that the audio file is ready to be sent; attaching the audio file to an electronic mail message; and sending the electronic mail message to the email recipient (page 7, lines 15-20).

In reference to claim 11, Fernandez discloses further comprising: disconnecting from the first server in order to communicatively connect to the second server; and reconnecting to the first server before sending- the recorded audio file to the email recipient (page 16, lines 22-31; page 22, line 29-page 23, line 5).

In reference to claim 12, Fernandez discloses wherein the reconnecting to the first server comprises providing the user with a plurality of options selected from the group consisting of: listening to a second audio file stored on the second server and reconnecting to the first server (page 16, lines 22-31; page 22, line 29-page 23, line 5).

In reference to claim 13, Fernandez discloses wherein the first server comprises an email server (page 5, lines 5-12; page 9, lines 2-26; page 11, lines 18-31).

In reference to claim 14, Fernandez discloses wherein the second server comprises an interactive voice response server (page 6, lines 4-11).

In reference to claim 15, Fernandez discloses wherein the first and second servers are connected by common platform means (Figure 3).

In reference to claim 16, Fernandez discloses wherein the audio file comprises a .wav file (page 17, lines 1-5).

In reference to claim 29, Fernandez discloses wherein the information uniquely identifying the wireless communication device comprises a telephone number

corresponding to the wireless communication device (i.e. logging into system using users mobile phone number; page 22, lines 5-8).

In reference to claim 31, Fernandez discloses wherein instructing the wireless communication device to connect to a voice server further comprises: transmitting to the wireless communication device a telephone number corresponding to the voice server (page 22, lines 20-30).

In reference to claim 32, Fernandez discloses wherein receiving input from the voice server indicating that the audio file is available further comprises: receiving information identifying the wireless communication device with which the audio file is associated (page 22, line 5-page 23, line 14).

In reference to claim 33, Fernandez discloses wherein the information identifying the wireless communication device with which the audio file is associated comprises a telephone number corresponding to the wireless communication device (i.e. logging into system using users mobile phone number; page 22, lines 5-8).

**Claims 17 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Angwin as applied to the claims above, and further in view Ball et al. (US Patent 6,240,391) hereinafter referred to as Ball.**

In reference to claim 17, Fernandez and Angwin fail to disclose wherein the sending the audio file to the email recipient comprises sending a hyperlink to the audio file stored on

the second server. Nonetheless, this would have been an obvious modification to the teachings of Fernandez and Angwin as further evidenced by Ball.

In an analogous art, Ball discloses a method for assembling and presenting voicemail messages (abstract). Ball further discloses sending a hyperlink to the audio file stored on the second server (column 16, lines –24; Figure 5-item 504). It would have been obvious for one of ordinary skill in the art to combine the known element of sending an audio file to an email recipient, as taught by Fernandez and Angwin, with the known element of a sending a hyperlink to the audio file stored on a server, as taught by Ball, without modification to their respective functions to yield the predictable result of an email comprising an hyperlink to the audio file being sent to a recipient.

In reference to claim 30, Fernandez and Angwin fail to disclose wherein the representation of the audio file comprises a link to the audio file stored on the voice server. Nonetheless, this would have been an obvious modification to the teachings of Fernandez and Angwin as further evidenced by Ball.

In an analogous art, Ball discloses a method for assembling and presenting voicemail messages (abstract). Ball further discloses link to the audio file stored on the voice server (column 16, lines –24; Figure 5-item 504). It would have been obvious for one of ordinary skill in the art to combine the known element of sending an audio file to an email recipient, as taught by Fernandez and Angwin, with the known element of a sending a hyperlink to the audio file stored on a server, as taught by Ball, without modification to their respective functions to yield the predictable result of an email comprising an hyperlink to the audio file being sent to a recipient.

**Claims 3 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Angwin as applied to the claims above, and further in view Oakes et al. (US Patent 6,205,342), hereinafter referred to as Oakes.**

In reference to claim 3, Fernandez and Angwin fail to disclose wherein receiving input from the user selecting an option to send the audio file further comprises: receiving input from the user selecting an option to compose a new email message; and receiving input from the user selecting an option to attach the audio file to the new email message. Nonetheless, this limitation was well known in the art at the time of the invention, as further evidenced by Oakes. Therefore, one of ordinary skill in the art would have readily recognized the advantages to implementing this modification.

In an analogous art, Oakes teaches a user of a wireless device (i.e. cellular phone) entering a message creation mode in order to compose an initial email file (i.e. text message), (column 3, line 63 to column 4, line 12 and Figure 4). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note method so as to increase the ease of generating email files (i.e. text message) for wireless device users, thereby increasing convenience (Oakes column 1, lines 6-10).

In reference to claim 28, Fernandez and Angwin fail to disclose wherein the email message comprises a new email message. Nonetheless, this limitation was well known in the art at the time of the invention, as further evidenced by Oakes. Therefore, one of

ordinary skill in the art would have readily recognized the advantages to implementing this modification.

In an analogous art, Oakes teaches a user of a wireless device (i.e. cellular phone) entering a message creation mode in order to compose an initial email file (i.e. text message), (column 3, line 63 to column 4, line 12 and Figure 4). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note method so as to increase the ease of generating email files (i.e. text message) for wireless device users, thereby increasing convenience (Oakes column 1, lines 6-10).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LASHANYA R. NASH whose telephone number is (571)272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaShanya R Nash/  
Examiner, Art Unit 2153  
March 27, 2008

/Glenton B. Burgess/  
Supervisory Patent Examiner, Art  
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